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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/346,063	07/01/1999	KENT J. SIEFFERT	1551.011US1	1973
70859 7590 02/19/2010 COMPUTER PATENT ANNUITIES NORTH AMERICA, LLC C/O CPA GLOBAL P.O. BOX 52050 MINNEAPOLIS, MN 55402				
EXAMINER				
NGUYEN, NGA B				
ART UNIT		PAPER NUMBER		
3684				
MAIL DATE		DELIVERY MODE		
02/19/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/346,063

Applicant(s)

SIEFFERT ET AL.

Examiner

Nga B. Nguyen

Art Unit

3684

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 November 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5 and 10-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5 and 10-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/02)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

1. This Office Action is the answer to the Amendment filed on November 12, 2009, which paper has been placed of record in the file.
2. Claims 5 and 10-14 are pending in this application.

Response to Arguments/Amendment

3. Applicant's arguments with respect to claims 5 and 10-14 have been fully considered but are not persuasive.

In response to the applicant's arguments that Kossovsky-provisional does not disclose *"presenting one or more terms of said interest for the proposed transfer and permitting the network user to select one or more of the terms of said interest"*, examiner submits that Kossovsky-provisional discloses that *"The pIX bidding process will allow the buyers to request specific payment or shipping terms, these terms and conditions will be treated as part of the bid. The auction chart will display the offered terms and conditions along side the bids shown. Further, when creating the product description, the seller will specify the range of terms and conditions acceptable to him and indicate how they are factored in bid evaluation"* (see *"Term and Conditions"*, Appendix pages 104-105).

In response to the applicant's arguments that Kossovsky-provisional does not disclose *"automatically adjusting the terms of transfer in the event no sufficient bids are gathered within a predetermined period of time"*, examiner submits that Kossovsky-provisional discloses that *"When the pIX auction master puts up the bids, he can start*

with a high bid, perhaps at which no bidder is willing to trade, and lower the bid gradually until he has sufficient bidders to clear his inventory" (the bid price is adjust because no bidder is willing to trade) (see "Control of Bids/Offer, Appendix, pages 101-102). Moreover, Kossovsky-provisional also discloses that "Dutch auctions could close at a pre specified time, when all the inventory has been sold, when the price has fallen to a pre specified level" (see "Rules for Closing the Auction", Appendix, page 103).

Thus, in Kossovsky-provisional, the auction has a predetermined period of time and the pIX auction master adjusts the bid price when no bidder is willing to trade.

Therefore, Kossovsky-provisional does disclose *"presenting one or more terms of said interest for the proposed transfer and permitting the network user to select one or more of the terms of said interest" and "automatically adjusting the terms of transfer in the event no sufficient bids are gathered within a predetermined period of time."*

4. Applicant's amendment necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 5 and 10-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Kossovsky et al (hereinafter Kossovsky), U.S. Patent Application Publication No. 2002/0004775.

Regarding to claim 5, Kossovsky discloses a method for facilitating transfer of an interest in an intellectual property asset via global computer network, the method comprising:

formulating a proposed transfer, by a computer system, of an interest in an intellectual property asset based on input submitted by a network user (*paragraphs 0043-0044, seller submits data describing the IP listed on the exchange*);

presenting, by the computer system, one or more terms of said interest for the

proposed transfer (*paragraphs 0043-0044, seller submits data describing the IP listed on the exchange and figures 5A-5C*);

permitting the network user, by the computer system, to select one or more of the terms of said interest (*paragraphs 0043-0044, seller submits data describing the IP listed on the exchange and figures 5A-5C*);

limiting, by the computer system, bidders via an access profile (*paragraph 0064 and 0153*);

defining, by the computer system, the proposed transfer based at least part on the terms selected by the user (*paragraphs 0043-0044, seller submits data describing the IP listed on the exchange and figures 5A-5C*); and

posting, by the computer system, the proposed transfer on a network resource residing on the global computer network (*paragraphs 0043-0044, seller submits data describing the IP listed on the exchange*).

Regarding to claim 10, Kossovsky discloses a method for facilitating transfer of interests in intellectual property assets via a global computer network, the method comprising:

auctioning, by the computer system, an interest in an intellectual property asset via a network resource residing on the global computer network, wherein auctioning an interest includes listing, as part of an auction process, an asset identifier corresponding to the asset and terms of transfer of the interest in the intellectual property asset (*paragraphs 0043-0044, seller submits data describing the IP listed on the exchange*);

limiting access, by the computer system, to the asset identifier and the terms of

transfer as a function of an access profile associated with each network user
(*paragraphs 0064 and 0153*);

permitting, by the computer system, the network user to select one or more of
the terms of said interest (*paragraphs 0043-0044, seller submits data describing the IP
listed on the exchange and figures 5A-5C*);

gathering bids from network users, by the computer system, (*paragraph 0172, the
participants submit bids to the exchange*); and

automatically adjusting the terms of transfer, by the computer system, in the
event no sufficient bids are gathered within a predetermined period of time (*paragraph
0173, e.g., the exchange auction master can start at a low bid, increase bid until the
number of buyers willing to buy his merchandise matches his inventory*).

Regarding to claim 11, Kossovsky discloses wherein limiting bidders via an
access profile includes accessing, by the computer system, a database of access
profiles, wherein each network user has an associated access profile (*paragraph 0153*).

Regarding to claim 12, Kossovsky discloses a method for auctioning an interest
in an intellectual property asset via a global computer network, the method comprising:

offering, by the computer system, the interest in the intellectual property asset via
a network resource residing on the global computer network, wherein the interest in the
intellectual property asset is defined by a proposed transfer agreement and a profile of
users granted access to the proposed transfer agreement (*paragraphs 0043-0044,
seller submits data describing the IP listed on the exchange; paragraphs 0064 and
0153*);

permitting, by the computer system, the network user to select one or more of the terms of said interest (*paragraphs 0043-0044, seller submits data describing the IP listed on the exchange and figures 5A-5C*);

collecting, by the computer system, bids from network users meeting the profile of users granted access to the proposed transfer agreement (*paragraph 0172, the participants submit bids to the exchange*); and

accepting, by the computer system, one of said bids (*paragraphs 0050-0051, seller accept bid*).

Regarding to claim 13, Kossovsky discloses wherein the proposed transfer agreement is a proposed licensing agreement (*paragraph 0009*).

Regarding to claim 14, Kossovsky discloses wherein the in intellectual property asset is a patent (*paragraph 0009*).

Conclusion

7. Claims **5 and 10-14** are rejected.
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Nga B. Nguyen whose telephone number is (571) 272-6796. The examiner can normally be reached on Monday-Thursday from 9:00AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi can be reached on (571) 272-6702.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-3600.

9. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
P.O. Box 1450
Alexandria, VA 22313-1450

Or faxed to:

(571) 273-8300 (for formal communication intended for entry),

or

(571) 273-6796 (for informal or draft communication, please label "PROPOSED" or "DRAFT").

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Nga B. Nguyen/

Primary Examiner, Art Unit 3684

February 10, 2010